

REMARKS/ARGUMENTS

Applicant respectfully requests reconsideration of the present application. No new matter has been added to the present application. Claims 1-25 have been rejected in the Office Action. Claims 1, 5, 9, 13, 16, and 21 have been amended, no new claims have been added, and no claims have been canceled in this Amendment. Accordingly, claims 1-25 are pending herein. Claims 1-25 are believed to be in condition for allowance and such favorable action is respectfully requested.

Interview Summary

Applicants' representative thanks the Examiner for granting a telephonic interview on August 14, 2007. During the interview, differences between the claimed invention and cited art, namely U.S. Patent Application Publication No. 2001/0020955 by Nakagawa et al ("Nakagawa") were discussed. In particular, Applicant noted that Nakagawa is directed to a system for providing a virtual space that is significantly different than the present invention and, as such, fails to describe multiple features of the claims. The Examiner indicated that clarifying claim amendments may help to clarify differences and overcome the cited. Applicants have submitted such clarifying amendments herein.

Amendments to the Claims

Claims 1, 5, 9, 13, 16, and 21 have been amended herein. Care has been exercised to avoid the introduction of new matter. Amendments to claims 5 and 16 were made to correct minor typographical errors. Support for amendments to claims 1 and 13 may be found in the Specification, for example, at p. 1, ¶ [0009]; p. 5, ¶ [0026]; p. 10, ¶ [0040]; p. 11, ¶ [0042]; p.

12, ¶ [0044]; and FIGS. 1, 4, and 7. Support for amendments to claims 9 and 21 may be found in the Specification, for example, at p. 5, ¶ [0026]; p. 15, ¶ [0052]; and FIGS. 1, 4, and 7.

Rejections based on 35 U.S.C. § 101

The Office Action rejected claims 1-11 and 13-25 under 35 U.S.C. § 101, indicating that the claims are directed towards non-statutory subject matter. In particular, page 3 of the Office Action alleges that the “result of the invention is merely numerical values without a practical application recited in the claims. It is not a real world result, and thus is not useful, concrete and tangible.” Applicants respectfully traverse this rejection and assert that the claims are directed to statutory subject matter.

According to MPEP § 2106, “[t]he claimed invention as a whole must accomplish a practical application. That is, it must produce a ‘useful, concrete and tangible result.’ *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of ‘real world’ value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); *In re Ziegler*, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.”

The Office Action states that the “result” of the present claims is “merely numerical values.” See Office Action, Page 2. However, Applicants submit that the “result” of the claims, as amended herein, is displaying three-dimensional items in a dynamic way that allows users to quickly view available items. In particular, the method of independent claim 1

includes “displaying a plurality three-dimensional items” and the computerized system of independent claim 13 recites components for “displaying a plurality of three-dimensional items.” Clearly, “displaying” is not “merely numerical values.”

Accordingly, Applicants respectfully submit that the claims are directed to a practical application in the technological arts – displaying three-dimensional items to assist organizing information on a computer system – that produces a useful concrete, and tangible result. The “result” of displaying three-dimensional items in accordance with embodiments of the claimed invention is that a user may view and organize items and folders associated with a computer in a manner that improves the user experience. For example, FIG. 1 and its accompanying discussion on p. 5, ¶ [0021] through p. 5, ¶ [0026] of the Specification as-filed, illustrates an exemplary embodiment in which three-dimensional items are used to expose a list of devices associated with a user’s computer system, thereby allowing the user to view the devices, assess information, and perform actions/tasks associated with the devices.

The Specification includes a variety of other indications of practical applications of the present invention that have useful, concrete, and tangible results, including the following:

The carousel display facilitates presentation of a limited set of items in a visually appealing and dynamic way. Providing a circle or an ellipse in three dimensions provides a clear overview at a glance of available features. The carousel provides a way to give additional information by bringing items to the front, based on status, importance, history or other factors. The carousel display also introduces an element of play. By clicking an item, a user is able to spin the carousel. This makes the view both an access point and an interesting place for the user to visit. The fact that users may want to visit the view would create an advantageous position for branding by independent vendors that might create their own items for display.

Specification, p. 17, ¶ [0062].

Furthermore, according to MPEP 2106, “[t]he applicant is in the best position to explain why an invention is believed useful. Office personnel should therefore focus their efforts on pointing out statements made in the specification that identify all practical applications for the invention. Office personnel should rely on such statements throughout the examination when assessing the invention for compliance with all statutory criteria. An applicant may assert more than one practical application, but only one is necessary to satisfy the utility requirement. Office personnel should review the entire disclosure to determine the features necessary to accomplish at least one asserted practical application.” Because claims 1-11 and 13-25 are directed to at least one practical application within the technological arts as indicated hereinabove, Applicants respectfully submit that the claims are directed to statutory subject matter that produce a useful, concrete, and tangible result. As such, Applicants respectfully request withdrawal of the rejections of the claims under 35 U.S.C. § 101.

Rejections based on 35 U.S.C. § 102

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegall Brothers v. Union Oil co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 2 USPQ 2d 1913, 1920 (Fed. Cir. 1989). *See also*, MPEP § 2131.

Claims 1-7, 10, 12-19, and 22-25 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Nakagawa. As Nakagawa fails to describe, either expressly or inherently,

each and every element recited in the claims as amended herein, Applicants respectfully traverse this rejection, as hereinafter set forth.

Referring initially to independent claim 1, a method for organizing and displaying items for a user interface is recited. The method includes displaying three-dimensional items that represent user information (e.g., items and files associated with a computer) around a perimeter. The perimeter is of a given geometric shape and forms a portion of a closed area. The three-dimensional items are positioned along the perimeter and are capable of being rotated around the perimeter. Accordingly, the method provides a compelling and dynamic way to present items associated with a computer to a user.

In contrast to the invention of claim 1, Nakagawa is directed to a system for providing a virtual space, such as a virtual town. *See, e.g., Nakagawa*, Abstract; p. 1, ¶ [0004]. Users visiting the virtual space may be represented within the virtual space as three-dimensional models (e.g., a man figure or an animal figure). *See, e.g., id.*, p. 1, ¶ [0004]; p. 2 ¶ [0048]. A user can move his/her model to arbitrary locations within the virtual space and the various users can interact with each other in the virtual space via their models. *See, e.g., id.*, p. 1, ¶ [0005]; p. 2 ¶ [0049].

Accordingly, Applicants respectfully submit that Nakagawa is directed to a system that is significantly different to the invention of claim 1 and, as such, fails to describe, expressly or inherently, multiple features of independent claim 1. For instance, Nakagawa fails to describe “arranging the three-dimensional items around a perimeter of a given geometric shape forming a portion of a closed area such that the three-dimensional items are positioned along the perimeter and are capable of being rotated around the perimeter.” Initially, it is unclear what the Patent Office believes is a “perimeter” within Nakagawa. Nakagawa discusses a virtual

space within which models may freely move about. It is possible that the Patent Office's position is that the virtual space discussed in Nakagawa implicitly has a perimeter – i.e., the boundary within which users may move their models. Regardless, Applicants respectfully submit that Nakagawa fails to describe three-dimensional items being positioned along the perimeter and capable of being rotated around the perimeter as recited in independent claim 1. Instead, models (which the Office Action appears to interpret as the three-dimensional items) may move freely about the virtual space to any arbitrary location. The models are not positioned along any perimeter and are not capable of being rotated around the perimeter.

As such, it is respectfully submitted that Nakagawa fails to describe, either expressly or inherently, each and every element of independent claim 1, and, as such, claim 1 is not anticipated by Nakagawa. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 1 under 35 U.S.C. § 102(b). Claim 1 is believed to be in condition for allowance and such favorable action is respectfully requested.

Independent claim 13 is directed a computerized system for organizing and displaying information to a user. The claim recites features for implementing a method similar to those recited in independent claim 1. For instance, the system of claim 13 includes "orientation controls for arranging the items around a perimeter of a given geometric shape that forms a portion of a closed area, the three-dimensional items being positioned along the perimeter and capable of being rotated around the perimeter." As such, it is respectfully submitted that Nakagawa fails to describe, either expressly or inherently, each and every element of independent claim 13 for at least the reasons cited above for claim 1. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 13 under 35 U.S.C. § 102(b). Claim 13 is believed to be in condition for allowance and such favorable action is respectfully requested.

Claims 2-7, 10, 12, 14-19, and 22-25 depend directly or indirectly from independent claims 1 and 13. As such, Applicants respectfully submit that claims 2-7, 10, 12, 14-19, and 22-25 are patentable over Nakagawa for at least the above-cited reasons and request withdrawal of the 35 U.S.C. § 102(b) rejections of these claims as well.

Rejections based on 35 U.S.C. § 103

A. Applicable Authority

Title 35 U.S.C. § 103(a) declares, a patent shall not issue when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” The Supreme Court in *Graham v. John Deere* counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the claimed invention and prior art references; and secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

To support a finding of obviousness, the initial burden is on the Office to apply the framework outlined in *Graham* and to provide some reason, or suggestions or motivations found either in the prior art references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the prior art reference or to combine prior art reference teachings to produce the claimed invention. See, *Application of Bergel*, 292 F. 2d 955, 956-957 (1961). Thus, in order “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference

or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” See MPEP § 2143. Recently, the Supreme Court elaborated, at pages 13-14 of *KSR*, it will be necessary for [the Office] to look at interrelated teachings of multiple [prior art references]; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by [one of] ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the [patent application].” *KSR v. Teleflex*, 127 S. Ct. 1727 (2007).

B. Rejections based on Nakagawa and Beier

Claims 8, 9, 11, 20, and 21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakagawa in view of U.S. Patent Application Publication No. 2003/0227453 by Beier et al. (“Beier”). As Nakagawa and Beier, either alone or in combination fails to teach or suggest all the claim limitations of each claim, Applicants respectfully traverse this rejection, as hereinafter set forth.

Claims 8, 9, 11, 20, and 21 depend from independent claims 1 and 13, and, as such, are patentable over Nakagawa for at least the reasons cited above. Beier fails to cure the deficiencies of Nakagawa with respect to its failure to teach or suggest multiple limitations of the base claims 1 and 13. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) of claims 8, 9, 11, 20, and 21.

Additionally, Applicants respectfully submit that Nakagawa is not modifiable in the manner that would be required to achieve the inventions recited in claims 8, 9, 11, 20, and 21. For instance, claims 8, 9, 11, 20, and 21 each include features directed toward rotating the

three-dimensional items around the perimeter upon receiving a user request. Applicants respectfully submit that there is no suggestion or motivation to modify Nakagawa because the modification would render the invention in Nakagawa unsatisfactory for its intended purpose. “If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).” MPEP § 2143.01. The intended purpose of the system in Nakagawa is built upon the notion of allowing users to freely move their models about a virtual space. The Office Action attempts to modify Nakagawa with Beier to provide the feature of rotating the three-dimensional items around the perimeter upon receiving a user request. Such a modification would require the Nakagawa system to maintain the items in association with the perimeter and allow a user to rotate the items around the perimeter. However, as noted, the Nakagawa system is built upon a virtual space in which users can individually move their own models. Such a modification would prevent users from moving their models to arbitrary locations within the virtual space. Accordingly, Applicants respectfully submit that the modification would render the system in Nakagawa unsatisfactory for its intended purpose, and thus there is no suggestion or motivation to modify Nakagawa with Beier.

Similarly, Applicants respectfully submit that there is no suggestion or motivation to modify Nakagawa with Beier because the modification would change the principle of operation of the system in Nakagawa. “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).” MPEP § 2143.01. The principle of

operation of the system in Nakagawa includes providing a virtual space in which users may freely and individually move their models. To modify Nakagawa with Beier in an attempt to achieve the claims' features would destroy the principle of operation of Nakagawa because models would have to be positioned along a perimeter and rotated around the perimeter upon receiving user request. As such, users would not be able to move their models freely about the virtual space as required by Nakagawa. Accordingly, Applicants respectfully submit that the modification would change the principle of operation of the Nakagawa system, and thus there is no suggestion or motivation to modify Nakagawa with Beier.

Accordingly, claims 8, 9, 11, 20, and 21 are patentable over Nakagawa and Beier for at least the reasons cited above. As such, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) of claims 8, 9, 11, 20, and 21.

CONCLUSION

For the reasons stated above, claims 1-25 are now in condition for allowance. Applicant(s) respectfully request withdrawal of the pending rejections and allowance of claims 1-25. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned by telephone prior to issuing a subsequent action. The Commissioner is hereby authorized to charge any additional amount required (or to credit any overpayment) to Deposit Account No. 19-2112.

Respectfully submitted,

/John S. Golian/

John S. Golian
Reg. No. 54,702

JSG/drb
SHOOK, HARDY & BACON L.L.P.
2555 Grand Blvd.
Kansas City, MO 64108-2613
816-474-6550